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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,331	06/26/2003	David W. Deaton	026656.0332	7922

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EXAMINER	
SHAH, AMEE A	
ART UNIT	PAPER NUMBER
3625	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/609,331	DEATON ET AL.	
	Examiner	Art Unit	
	Amee A. Shah	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 June 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20,96 and 97* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20,96 and 97* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 June 2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *7/31/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-20, 96 and 97 are pending in this action.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) and (5) because: (1) reference character "102" has been used to designate both a step for an action needed (Specification, page 30, lines 1-2) and an arrow for coupon UPC (Specification, page 36, line 16 and Fig. 9); and (2) they include the following reference character(s) not mentioned in the description: 45, 72, 83, 138, 202 and 100.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the second paragraph of 35 U.S.C. §112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14, 16 and 17 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 14 and 16 recite the limitation "the first retail store" in line 3 of the claims. There is insufficient antecedent basis for this limitation in the claims. Because claim 17 is a dependency of claim 16, it inherits the same deficiency and is rejected on the same basis.

Claims 8-10 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 8 recites the limitation of transmitting to the customer a proposed shopping list prior to receiving a shopping list from a customer. Therefore, the method of claim 8 would be detecting product purchase information, storing product purchase information in association with customer identification numbers, transmitting a proposed shopping list to a customer before receiving a shopping list from that customer and initiating communication of price information. This is incomplete as it omits at least one essential step, such omission amounting to a gap between the steps. See MPEP § 2172.01. In order to transmit a proposed shopping list, there must be some correlation between the association of purchase information, the customer identification number, and the proposed shopping list, e.g. using the particular customer's purchase information to create a proposed shopping list. For purposes of this action only, the Examiner interprets the claim to include a step of correlating customer product purchase information with the particular customer in order to create a proposed shopping list based on the customer's past or current purchase history, as provided for in the Specification (pages 9 and 21).

Because claims 9 and 10 are dependencies of claim 8, they inherit the same deficiencies, are rejected on the same bases, and interpreted in the same manner.

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> > (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 11, 16, 17, 96 and 97 are rejected under 35 U.S.C. §102(e) as being anticipated by Reuhl et al., US 5,873,069, cited by Applicant (hereafter referred to as "Reuhl").

Referring to claim 1. Reuhl discloses a method for use in marketing, comprising:

- detecting, at a remote computer, product purchase information of a plurality of retail stores, the product purchase information including price information, the remote computer located remote from the retail stores (col. 3, lines 18-28, col. 8, lines 64-68 and col. 10, lines 15-32 – note that the product purchase information is detected "enterprise-wide (e.g. a retailer with many locations in many market areas)," as well as from competitors, thereby comprising a plurality of retail stores);

- receiving, at the remote computer, a shopping list of a customer, the shopping list including at least one item (col. 10, lines 54-61 – note the shopping list of at least one item is the entering of product identification code by the user); and
- in response to receiving the shopping list initiating communication, to the customer by the remote computer, of price information associated with the at least one item on the shopping list for the plurality of retail stores (Fig. 8 and col. 11, lines 11-23 – note the price information is displayed as the result of the search).

Referring to claim 2. Reuhl further discloses the method of Claim 1 wherein initiating communication comprises transmitting an electronic mail message for receipt by the customer (col. 11, lines 11-23 – note the electronic mail message is the display presented to the customer).

Referring to claim 4. Reuhl further discloses the method of Claim 1 wherein receiving a shopping list of a customer comprises receiving an electronic mail message including the at least one item (col. 11, lines 2-10 – note the message includes the product identification of the item).

Referring to claim 11. Reuhl also discloses the method of Claim 1 further comprising initiating, by the remote computer, communication of an incentive associated with the at least one item to the customer in response to receiving the shopping list (col. 11, lines 11-24 – note the incentive is the value added promotion being offered).

Referring to claim 16. Reuhl also discloses the method of Claim 11 further comprising comparing, by the computer, the price of the at least one item at a first one of the plurality of retail stores to the lowest price at which the at least one item was purchased from the first retail store within a predetermine time period, the lowest price determined from the product purchase information, and wherein the incentive comprises a discount sufficient to lower the effective price at the first retail store on the at least one item to match or beat the lowest price (Fig. 10, col. 10, lines 27-31 and col. 12, lines 8-27).

Referring to claim 17. Reuhl further discloses the method of Claim 16 wherein the predetermined time period is approximately one hour from the receipt of the shopping list (col. 10, lines 27-31 – note that with the predetermined price frequencies, a price request, i.e. shopping list, may be received close to one hour from the pricing time).

Referring to claims 96 and 97. All of the limitations in apparatus claims 96 and 97 are closely parallel to the limitations of method claim 1, analyzed above and are rejected on the same bases.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(e), (f) or (g) prior art under 35 U.S.C. §103(a).

Claims 3, 5 and 7 are rejected under 35 U.S.C. §103(a) as being unpatentable over Reuhl in view of Harms et al., US 6,070,147, cited by Applicant (hereafter referred to as "Harms").

Referring to claim 3. Reuhl discloses the method of Claim 1, as discussed above, but does not specifically disclose receiving product purchase information of a plurality of retail stores on a substantially real-time basis. Harms, in the same field of endeavor and/or pertaining to the same issue, discloses a method and system for administering a loyalty marketing program wherein product purchase information of a plurality of retail stores is received on a substantially real-time basis (col. 6, lines 32-46 and col. 7, lines 22-27).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of Reuhl to include the teachings of Harms to allow for the receiving of product purchase information of a plurality of retail stores on a substantially real-time basis. One of ordinary skill in the art would have been motivated to do so based on the

knowledge generally available to one of ordinary skill in the art at the time of the invention that doing so would ensure that the prices are the most recent and reflect the latest changes made by the stores, thus improving the accuracy of the method and increasing customer satisfaction.

Referring to claim 5. Reuhl discloses the method of Claim 1, as discussed above, but does not specifically disclose receiving a shopping list of a customer comprising receiving information from the customer over the Internet. Harms, in the same field of endeavor and/or pertaining to the same issue, discloses a method and system for administering a loyalty marketing program including communicating marketing information over the Internet (col. 6, lines 32-46 and col. 7, lines 22-27).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of Reuhl to include the teachings of Harms to allow for the receiving a shopping list of a customer to comprise receiving information from the customer over the Internet. One of ordinary skill in the art would have been motivated to do so based on the knowledge generally available to one of ordinary skill in the art at the time of the invention that doing so would allow for receiving the information without a proprietary network, thus decreasing costs for the users of the method, and would also enable real-time responses to the customer at the point of sale, thus saving time.

Claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over Reuhl in view of Harms and further in view of Stack, US 6,076,070, cited by Applicant (hereafter referred to as "Stack).

Referring to claim 6. Reuhl in view of Harms discloses the method of Claim 5 including receiving information from the customer over the Internet, but does not discloses receiving information inputted into a web page associated with the remote computer. Stack, in the same field of endeavor and/or pertaining to the same issue, discloses a method and apparatus for a computer-implemented on-line price comparison and marketing including receiving information inputted into a web page associated with the remote computer (Fig. 5 and col. 5, lines 34-42 – note that as the customer interacts with the vendors' sites, information is inputted into a web page, which is inherently included with a web site).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of Reuhl and Harms to include the teachings of Stack to allow for the receiving of information to be inputted into a web page associated with the remote computer. One of ordinary skill in the art would have been motivated to do so based on the knowledge generally available to one of ordinary skill in the art at the time of the invention that doing so would allow customers to communicate from their homes, thus adding convenience to the customer.

Claims 7-10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Reuhl in view of Herz et al., US 2001/0014868 (hereafter referred to as "Herz").

Referring to claim 7. Reuhl discloses the method of Claim 1, as discussed above, but does not specifically disclose storing product purchase information from the plurality of retail stores in association with customer identification numbers. Herz, in the same field of endeavor and/or pertaining to the same issue, discloses a method and system for customizing prices and

promotions tailored to individual shoppers or types of shoppers including storing product purchase information from the plurality of retail stores in association with customer identification numbers (Fig. 1 and ¶¶0024 and 0029-0035 – note the customer identification number is the identity of the shopper).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of Reuhl to include the teachings of Herz to allow for the storing product purchase information from the plurality of retail stores in association with customer identification numbers. One of ordinary skill in the art would have been motivated to do so based on the suggestion taught by Herz that doing so would allow the tracking of product purchase information for each identified customer or type of customer which may then be used for further marketing analysis and/or in providing more targeted offers (¶0037).

Referring to claim 8. Reuhl in view of Herz discloses the method of Claim 7 further comprising transmitting to the customer a proposed shopping list prior to receiving the shopping list including at least one item (Herz, ¶¶0262, 0298-0301 and 0315). One of ordinary skill in the art would have been motivated to do so based on the suggestion taught by Herz that doing so would maximize profit by selecting promotions, including suggested shopping lists, based on purchase history so as to increate the likelihood of a customer purchase (¶0262).

Referring to claim 9. Reuhl in view of Herz discloses the method of Claim 8 wherein the proposed shopping list comprises products previously purchased by the customer (Herz, ¶¶0298-0301). One of ordinary skill in the art would have been motivated to do so based on the

suggestion taught by Herz that doing so would reach maximize profit by selecting promotions, including suggested shopping lists, based on purchase history so as to increate the likelihood of a customer purchase (¶¶0262 and 0298).

Referring to claim 10. Reuhl in view of Herz discloses the method of Claim 8 wherein the proposed shopping list comprises products previously purchased by the customer in the customer's most recent shopping transaction with one of the retail store (¶¶0298-0303). One of ordinary skill in the art would have been motivated to do so based on the suggestion taught by Herz that doing so would maximize profit by selecting promotions, including suggested shopping lists, based on purchase history so as to increate the likelihood of a customer purchase (¶0262).

Claims 12-15 and 18-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Reuhl in view of Official Notice.

Referring to claims 12, 13 and 18-20. Reuhl discloses the method of Claim 11, as discussed above, but does not explicitly disclose the incentive comprising a discount on the at least one item, or a discount on a product competitive with the at least one item. However, official notice is taken that using such types of incentives as a discount on the at least one item and a discount on a product competitive with the at least one item, was old and well known in the art at the time of the invention. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have incorporated such incentives into the incentives provided in the method of Reuhl. One of ordinary skill in the art would have been motivated to

do so based on the knowledge generally available to one of ordinary skill in the art at the time of the invention that doing so would allow for the customer to ensure that the prices are the most recent and reflect the latest changes made by the stores, thus improving the accuracy of the method and increasing customer satisfaction.

Referring to claim 14. Reuhl in view of Official Notice discloses the method of Claim 13, and further comprising comparing, by the computer, the price of the at least one item at a first one of the plurality of retail stores to the price of the competitive item at the first retail store, the price of the at least one item and the competitive item at the first retail store determined from the product purchase information (Reuhl, Fig. 10 and col. 12, lines 8-27), and wherein the incentive comprises a discount sufficient to lower the effective price on the competitive item to match or beat the price of the at least one item (Reuhl, Fig. 10, col. 7, lines 17-21 and col. 11, line 64 through col. 12, line 27).

Referring to claim 15. Reuhl in view of official notice discloses the method of Claim 13, wherein the price of the competitive item comprises the price at which the competitive item was purchased within an hour of the receipt of the shopping list (col. 10, lines 27-31 – note that the predetermined price frequencies may be within one hour of the receipt of the list).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(1) Giuliani et al., US 5,974,399, discloses a method and system for customizing purchase incentives, such as coupons, based on customer's purchase history of buying competitor products and prices paid for products (see, e.g., Abstract and cols. 4-9).

(2) Jacobi et al., US 2001/0021914 A1, discloses a system and method for recommending items to users based on items previously selected by the user, such as items previously purchased, viewed or placed in an electronic shopping cart (see, e.g., Abstract, Fig. 5 and pages 3-9).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amee A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAS
February 12, 2007

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